

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

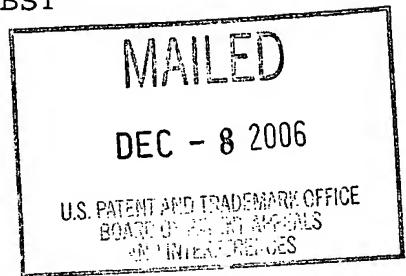
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FLYNN and GARY HERBST

Appeal No. 2006-2321
Application No. 10/706,254

ON BRIEF



Before JERRY SMITH, RUGGIERO, and SAADAT, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 2, 5-13, 16, and 17. Claims 3, 4, 14, and 15 have been indicated to be allowable by the Examiner, and claim 18 has been canceled.

Appeal No. 2006-2321
Application No. 10/706,254

The disclosed invention relates to the self-servo writing of a hard disk drive (HDD) in which write control bits are associated with servo pattern data bits to selectively disable or enable a write gate in a HDD write channel, the write gate being disabled or enabled without deenergizing the write channel. More particularly, from one timing mark to the next, a single write delay is calculated which enables the writing of the next timing mark and portions of the radial pattern and servo pattern between the timing marks.

Claim 1 is illustrative of the invention and reads as follows:

1. A HDD, comprising:

at least one write channel including at least one write gate; and

control circuitry encoding write control bits for controlling the write gate to selectively enable writing data bits associated with a servo pattern onto at least one disk.

The Examiner relies on the following prior art:

Hussein	6,285,521	Sep. 04, 2001
Bryant et al. (Bryant)	6,785,075	Aug. 31, 2004 (filed July 26, 2001)

Appeal No. 2006-2321
Application No. 10/706,254

Claims 1 and 2 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Hussein. Claims 5-13, 16, and 17 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Hussein in view of Bryant with respect to claims 5, 12, 13, and 16, and Bryant in view of Hussein with respect to claims 6-11 and 17.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

¹ The Appeal Brief was filed December 26, 2005. In response to the Examiner's Answer mailed March 7, 2006, a Reply Brief was filed March 11, 2006 which was acknowledged and entered by the Examiner as indicated in the communication mailed May 19, 2006.

Appeal No. 2006-2321
Application No. 10/706,254

It is our view, after consideration of the record before us, that the Hussein reference fully meets the invention as set forth in claims 1 and 2. We are further of the opinion that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 5-13, 16, and 17. Accordingly, we affirm-in-part.

We consider first the Examiner's 35 U.S.C. § 102(b) rejection of appealed claims 1 and 2 based on Hussein. We note that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

With respect to independent claim 1, the Examiner indicates (Answer, page 3) how the various limitations are read on the disclosure of Hussein. In particular, the Examiner points to the illustration in Hussein's Figure 1 as well as the discussion at

Appeal No. 2006-2321
Application No. 10/706,254

column 5, lines 42-60 in relation to the described write channel 68, write gate WG2, and servo controller 98. In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Hussein so as to establish a case of anticipation. In particular, Appellants' arguments focus on the contention (Brief, pages 5 and 6; Reply Brief, pages 1 and 2) that, in contrast to the claimed invention, Hussein does not write a servo pattern onto a disk but, rather, writes only conventional client user data.

After reviewing the language of appealed independent claim 1 in light of Appellants' arguments, however, we find that such arguments are not commensurate with the scope of the claim.

Appeal No. 2006-2321
Application No. 10/706,254

Although we don't disagree with Appellants' assertions (Brief, page 5) that the term "servo pattern" has a recognized meaning in the art distinct from the conventional writing of user data to a disk, and further that the Hussein reference does not disclose the writing of servo patterns, it is apparent that the language of claim 1 does not recite writing a "servo pattern." Instead, claim 1 merely requires writing "data bits" (not servo data bits as pointed out by the Examiner) which are "associated with a servo pattern."

We are also in agreement with the Examiner that the writing of data bits in Hussein, even though such data may be client user data, is "associated with a servo pattern" since the servo controller 98 which reads the servo sector data 158 operates to control the write gates of the read/write channel 68. This operation is verified by Hussein as indicated at column 5, lines 42-60 and as well as the discussion beginning at column 10, line 39. It is our opinion that Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Hussein, the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 1, as well as dependent claim 2 not separately argued by Appellants, is sustained.

We do not, however, sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 5, 12, 13, and 16 based on the proposed combination of Hussein in view of Bryant. According to the Examiner (Answer, pages 5, 6, and 12-14), Bryant has been added to Hussein to address the deficiency of Hussein in disclosing the writing of servo patterns. In our view, however, the disclosure of the Bryant reference has little relevance to the system of Hussein and, at best, provides only a disclosure that self-servo writing is known in the art. From our review of Bryant, the problems addressed by the Bryant reference, i.e., the alignment of self-servo writing fields with previously stored data on a disk, simply do not exist in the Hussein reference which, from our earlier discussion, has no concern with self-servo writing in the first instance. In our opinion, given the disparity of problems addressed by the prior art references, and

the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could come only from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We also do not sustain the Examiner's obviousness rejection of claims 6-11, and 17 based on the combination of Bryant in view of Hussein. The Examiner proposes (Answer, page 8) to modify the self-servo writing disclosure of Bryant with the addition of the selective gate enabling and disabling write teachings of Hussein "in order to improve the system performance of a hard disk drive." We find the Examiner's position, however, to be totally devoid of any evidentiary support on the record. While the Examiner (id.) does make reference to column 2, lines 29-32 of Hussein which suggests the saving in power consumption by the use of write gate selective enabling and disabling, there is no evidence to support the position that such a technique would also apply to self-servo writing since Hussein is not concerned with self-servo writing. It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record before us.

Appeal No. 2006-2321
Application No. 10/706,254

It is well settled that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).

In summary, we have sustained the Examiners 35 U.S.C. § 102(b) rejection of claims 1 and 2, but have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of claims 5-13, 16, and 17. Accordingly, the Examiner's decision rejecting appealed claims 1, 2, 5-13, 16, and 17 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004).

Appeal No. 2006-2321
Application No. 10/706,254

AFFIRMED-IN-PART

Jerry Smith

JERRY SMITH
Administrative Patent Judge

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Appeal No. 2006-2321
Application No. 10/706,254

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